

Applicants : Ilaria MELONI and Alessandra RENIERI
U.S. Serial No.: 10/507,145
Filed : September 8, 2004
Page : 2

REMARKS

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Claims 1-13 are pending in this application.

Election/Restrictions Requirement

The Examiner to whom this application is assigned indicated that under 35 U.S.C. § 121, restriction to one of the following groups of inventions is required:

- I. Claim(s) 1 and 2, drawn to a nucleic acid molecule.
- II. Claim(s) 3-6, drawn to a method to detect in a subject at least one mutation of the gene encoding for the FACL4 protein.
- III. Claim(s) 7 and 8, drawn to a diagnostic kit.
- IV. Claim(s) 9 and 10, drawn to a FACL4 protein.
- V. Claim(s) 11 and 12, drawn to a method to determine the enzymatic activity of FACL4 protein.
- VI. Claim(s) 13, drawn to a diagnostic kit.

In response, Applicants respectfully traverse the above restriction.

Under MPEP, there are two criteria for a proper requirement for restriction between patentable distinct inventions: (A) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) there must be a serious burden on the Examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). If the

Applicants : Ilaria MELONI and Alessandra RENIERI
U.S. Serial No.: 10/507,145
Filed : September 8, 2004
Page : 3

search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes independent claims or distinct inventions.

Applicants further submit that claims 1-13, Groups I-VI, do not require restriction as they are connected by a single relationship, the method, diagnosis and/or uses of the FACL4 protein.

In addition, Applicants maintain that the Examiner would not be seriously burdened by searching and examining all of the pending claims in a single application. A search for the key term FACL4 core protein (Group IV) will reveal the encoding sequence or a fragment of the FACL4 gene (Group I) which will further reveal the mutation and the uses of the mutation for diagnosis of the FACL4 protein (Group II and III) and the method to determine the enzymatic activity of the FACL4 protein (Group V) and the diagnosis method using these enzymatic methods (Group VI) (MPEP § 802.01).

Given the single, searchable relationship, the Examiner would not be seriously burdened by searching and examining the claims of these groups in a single application. (See MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). Accordingly, Applicants request withdrawal of the restriction of claims 1-13.

Applicants : Ilaria MELONI and Alessandra RENIERI
U.S. Serial No.: 10/507,145
Filed : September 8, 2004
Page : 4

Election of Invention

In the event the above discussion does not convince the Examiner to withdraw the restriction requirement, Applicants hereby elect Group VI, drawn to a diagnostic kit.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants : Ilaria MELONI and Alessandra RENIERI
 U.S. Serial No.: 10/507,145
 Filed : September 8, 2004
 Page : 5

No fee is deemed necessary in connection with the filing of this Response. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

I hereby certify that this paper is being facsimile transmitted to:
 Commissioner for Patents
 P.O. Box 1450
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 on the date shown below.
Albert Wai-Kit Chan 6/16/06
 Albert Wai-Kit Chan Date
 Reg. No. 36,479

Respectfully submitted,
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